

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

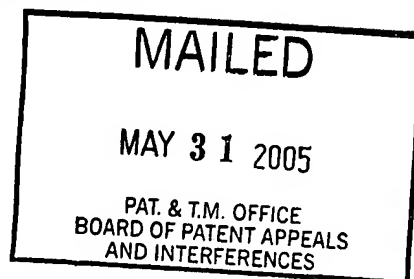
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TADASHI TAKANO and SUSUMU ANDO

Appeal No. 2005-0478
Application No. 10/064,363

HEARD: May 5, 2005



Before HAIRSTON, LEVY, and MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 4-6.

Invention

Appellants' invention relates to an armature for a rotating machine having a circular core of a magnetic material and a plurality of magnetic pole teeth extending radially from said circular core and terminating at terminal ends spaced from said circular core. Each of the magnetic pole teeth defining a core with an enlargement formed at the terminal end of the core. This defines slots formed between adjacent magnetic pole teeth. Each of the slots has a mouth formed between adjacent enlargements. An insulator extends at least along the

side of the enlargements facing the circular core for protecting windings formed by a winding needle from damage by the winding needle. Appellants' specification at page 2, paragraph [0005].

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An armature for a rotating machine having a circular core of a magnetic material and a plurality of magnetic pole teeth extending radially from said circular core and terminating at terminal ends spaced from said circular core, each of said magnetic pole teeth defining a core and an enlargement formed at the terminal end of said core, to define slots formed between adjacent magnetic pole teeth, each of said slots having a mouth formed between adjacent enlargements, an insulating bobbin having a circular portion lying on one side of said circular core and leg portions that extend for the length of said pole teeth at least on the sides of said slots and insulator portions extending at least along the side of said enlargements facing said circular core for protecting windings formed by a winding needle from damage by the winding needle.

References

The reference relied on by the Examiner is as follows:

Uchida et al. (Uchida)	5,763,978	Jun. 9, 1998
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The reference relied on by this Board is as follows:

Scherzinger et al. (Scherzinger) ¹	5,698,923	Dec. 16, 1997
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Rejections At Issue

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 103 as being obvious over Uchida.

¹ Copy supplied by Appellants as part of the Information Disclosure Statement filed on December 8, 2004.

Throughout our opinion, we make references to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1 and 5-6 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claim 4 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new ground of rejection of claims 1 and 4. The basis for this is set forth in detail below.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellants have indicated that for purposes of this appeal, the claims stand or fall separately. See page 2 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable.

² Appellants filed an appeal brief on December 9, 2003. The Examiner mailed an Examiner's Answer on April 29, 2004.

I. Whether the Rejection of Claims 1 and 5-6 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1 and 5-6. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. ***See also Piasecki***, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." ***Oetiker***, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of

record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 3 of the brief, that the claim distinguishes over the Uchida patent as the claimed "insulator portions extending at least along the side of said enlargements" are "for protecting windings . . . from damage by the winding needle." We find this argument unpersuasive.

We find that "for protecting windings . . ." is an intended use of the Appellants' claimed "insulator portions extending at least along the side of said enlargements." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the situation before us, figure 4(b) of Uchida shows that the opening for the nozzle (42) of the winding machine is between insulator portions (32) extending at least along enlargement (12). The insulator portions are inclined into slot (20). We find that as a nozzle (42) is inserted into slot (20) the insulator portion (32) would bend into the slot and protect at least some of the windings from damage by the nozzle (42).

In view of the above discussion, it is our view, that Uchida teaches all the features of claim 1. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” **Jones V. Hardy**, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). **See also In re Francalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).³

As to claim 5, Appellants argue, “Fig. 2 . . . fails to show any nozzle tip.” We find this argument unpersuasive as Uchida’s teaches a nozzle (item 42) at column 6, line 43.

As to claim 6, Appellants argue that Uchida fails to show an opening smaller than the nozzle tip. We find this argument unpersuasive as the opening shown in figure 2 of Uchida is deformed by the nozzle and is thus smaller.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103 of claims 1 and 5-6.

II. Whether the Rejection of Claim 4 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 4. Accordingly, we reverse.

³ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. **In re Bush**, 296 F.2d

With respect to dependent claim 4, Appellants argue at page 2 of the brief that figure 2 of Uchida fails to teach that the “insulator portions have a greater thickness than the insulating bobbin leg portions.” We agree. We have reviewed the Uchida reference and find that it does not recite the “greater thickness” as argued in the rejection at page 5 of the answer. Further, we find that the Examiner’s reliance on figure 4b at page 7 of the answer is misplaced as the accompanying detailed description gives no hint as to what thickness is being represented in figure 4b.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

III. Rejection of Claims 1 and 4 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority under 37 CFR § 41.50(b).

Claims 1 and 4 are rejected under 35 U.S.C. § 102 as being clearly anticipated by figures 2 and 3 of Scherzinger.

Appellants have admitted that Scherzinger anticipates at least claim 1.⁴ We have reviewed Scherzinger and find that it also teaches the subject matter of claim 4 as the insulator portions (36) in figure 2 have a thickness greater than the bobbin leg portions (40).

491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 150 USPQ 441, 444 n.2 (CCPA 1966).

⁴ Appellants’ representative admitted at the Oral Hearing held at the Board of Patent Appeals and Interferences on May 5, 2005, that the Scherzinger patent anticipates at least some of the claims.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1 and 5-6; we have not sustained the rejection under 35 U.S.C. § 103 of claim 4; and we have entered a new ground of rejection against claims 1 and 4 under 37 CFR § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . .
- (2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record. . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 CFR § 41.50(b)


KENNETH W. HAIRSTON
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

ARM/lbg

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